

Appl. No. 09/837,711
Amdt. dated October 12, 2005
Amendment under 37 CFR 1.116 Expedited Procedure
Examining Group 1652

PATENT

REMARKS/ARGUMENTS

Claims 71-83 are pending in this application. Applicants note with appreciation that the rejection under 35 U.S.C. § 112, first paragraph, for alleged lack of enablement is withdrawn. The rejection under §112, first paragraph, for alleged lack of written description is maintained. The claims remain rejected under §112, second paragraph, for allegedly being indefinite. The rejection for obviousness-type double patenting is also maintained. Each of the rejection is addressed below.

Rejection under 35 U.S.C. § 112, first paragraph

In the Office Action, the Examiner continues to reject all the pending claims for allegedly lacking written description. In particular, the Examiner is concerned that the claims encompass both man-made and wild-type glycosidases that can be altered to produce synthetic enzymes. At the bottom of page 3 of the Office Action, the Examiner suggests that amending the claims to clarify that the glycosidase enzyme is a wild-type enzyme would obviate this rejection. The claims have been amended as suggested by the Examiner. In particular, claims 71-73, 77, 81, and 82 have been amended to recite explicitly that the enzymes used in the methods of the invention are mutated forms of wild-type glycosidase enzymes. Support for the claim amendments is replete throughout the specification.

In light of the claim amendments tracking the Examiner's suggestions, the rejection of the claims is obviated. Withdrawal of the rejection is respectfully requested.

Rejection under 35 U.S.C. § 112, second paragraph

Claim 71 stands rejected because the preamble refers to a method for synthesizing "a glycoside product," whereas the body of the claim refers to an "oligosaccharide." The claim has been amended to conform the body of the claim to the language of the preamble. Withdrawal of the rejection is respectfully requested.

Claim 71 also stands rejected for reference to a "good" leaving group. The properties that render a leaving group "good" are allegedly unclear. The Examiner also suggests new language to clarify the relationship between the wild-type enzyme and its substrate.

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Claim 71 has been amended to delete the term "good." In addition, the relationship between the wild-type enzyme and its substrate has been described in language as suggested by the Examiner. Withdrawal of the rejection is respectfully requested.

Obviousness-type Double Patenting

The rejection of the claims over the claims of US Patent Nos. 5,716,812 and 6,284,494 is overcome by the attached Terminal Disclaimer. Withdrawal of the rejection is respectfully requested.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance and an action to that end is respectfully requested. If a telephone conference would expedite prosecution of this application, the Examiner is invited to telephone the undersigned at 415-576-0200.

Respectfully submitted,



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Attachments

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